REMARKS

The Official Action mailed September 1, 2004, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to January 1, 2005. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statement filed on January 6, 2000.

The Applicant notes the *partial* consideration of the Information Disclosure Statements filed on August 11, 2003, and November 25, 2003. Specifically, the Applicant respectfully requests an indication of the consideration of (1) the "Written Notification of Reason for Refusal" mailed May 15, 2003, and cited in the Information Disclosure Statement filed August 11, 2003, and (2) the "Written Notification of Reason for Refusal" mailed October 23, 2003, and cited in the Information Disclosure Statement filed November 25, 2003, both of which were timely filed and properly cited in full conformance with 37 CFR 1.97 and 1.98.

The Official Action asserts that documents (1) and (2) are not themselves prior art (page 2, Paper No. 26) and "can not be considered," but this ignores the information contained in documents (1) and (2), which may be material to patentability. Whether or not documents (1) and (2) are themselves prior art is irrelevant to the Examiner's duty to consider information timely and properly submitted to the Office in accordance with 37 CFR 1.97 and 1.98 (see MPEP § 609) and Applicant's duty of disclosure (see MPEP § 2000). In the present case, documents (1) and (2) discuss other references and may include information that is material to the patentability of the claims of the present invention, and the Applicant is required to submit such information to the Patent Office under the duty of disclosure (MPEP § 2000), which the Applicant has done in full accordance with 37 CFR 1.97 and 1.98. MPEP § 609 states clearly that "An information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 37

CFR 1.98 will be considered by the examiner assigned to the application" (emphasis added). That is, an Examiner has a duty to consider all information disclosed to the Patent Office, whether such information is prior art or not.

The Examiner is invited to signify consideration of documents (1) and (2) in any manner deemed appropriate, preferably by placing initials next to the citation on Form PTO-1449, but such consideration may also be signified by making a statement on the record in a subsequent communication with the Applicant, i.e. "The Examiner has considered the 'Written Notification of Reason for Refusal' mailed May 15, 2003, and cited in the Information Disclosure Statement filed August 11, 2003, and the 'Written Notification of Reason for Refusal' mailed October 23, 2003, and cited in the Information Disclosure Statement filed November 25, 2003." Due to the fact that the Examiner has elected to strike through the citation of documents (1) and (2), it is unclear on the record whether the Examiner has considered documents (1) and (2). Also, the Examiner's subsequent explanations of the situation also do not make clear whether the information contained in documents (1) and (2) have been considered as required by the Rules. Therefore, the Applicant again respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of documents (1) and (2).

As a courtesy to the Examiner, the Applicant has attached a clean copy of the Form PTO-1449 submitted with each of the Information Disclosure Statements filed August 11, 2003, and November 25, 2003. It is noted that the Applicant is merely resubmitting the above Forms as a courtesy to the Examiner. It is respectfully submitted that the above-referenced documents were properly and timely filed on August 11, 2003, and November 25, 2003, respectively, and should be accorded their filing date for the purposes of consideration and compliance with 37 CFR 1.97 and 1.98.

Claims 1-7 are pending in the present application, of which claims 1, 4 and 7 are independent. Claims 1, 4 and 7 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 1 of the Official Action rejects claims 1, 4 and 7 as obvious based on the combination of U.S. Patent No. 5,862,104 to Matsumoto and U.S. Patent No. 6,091,884 to Yuen et al. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 1 and 4 have been amended to recite a first system controller that stores received text information in a capturing buffer region when a first key instructs to selectively capture the received text information. Independent claim 7 has been amended to recite storing text information selectively designated with a designating key in a storage memory. Support for the amendments may be found in the specification, for example, at page 25, lines

12-20. For example, Figure 2 illustrates an example of the above-referenced selective capture or selective designation feature at Step S53 where the device or method determines whether a capturing key has been depressed before proceeding with Step S54, "write received text information in display buffer region in capturing buffer region at address WP" (see page 25, line 12+). For the reasons provided below, Matsumoto and Yuen, either alone or in combination, do not teach or suggest at least the above-referenced features of the present invention.

Matsumoto, at column 5, lines 23-47 discloses the following (emphasis added):

> When the entire system is controlled by the controller 55 of the audio amplifier 4, the text searching and recording mode is set up. With the input key pad 56 of the audio amplifier 4, a desired music program title or a desired artist name is input. The FM tuner 1 receives an FM text multiplexed broadcast. The multiplexed text decoder 14 decodes text and graphic information of the FM text multiplexed broadcast. An output signal of the multiplexed text decoder 14 is supplied to the controller 55 of the audio amplifier 4 through the bus 6. The controller 55 compares the received text information with the pre-set text information.
>
> As described previously, a sub program in association with a main program in an FM text multiplexed broadcast includes a music program title and an artist name of a music program of a main program that is being broadcast. Thus, when the received text information is compared with the pre-set text information, it can be determined whether or not the music program title and artist name obtained by the received text information accord with the pre-set music program title and artist name. When it has been determined that they accord, the controller 55 of the audio amplifier 5 supplies a record command to the controller 43 of the MD player and recorder 3. Thus, the MD player and recorder 3 can record a music program corresponding to a desired artist name to the mini disc 31.

The Applicant respectfully submits that Matsumoto involves a technique where a user sets a title name beforehand and the pre-set title name is compared with a title name of the music received by an FM broadcast. If the pre-set title name coincides with the title name of received music, which is included in the received text data, then the received music and its title name are stored in a Mini Disc (MD) device. Thus, in

Matsumoto, the received text data is automatically captured as a whole in the user's MD device.

By contrast, in the present invention, a first system controller stores received text information in a capturing buffer region when a first key instructs to selectively capture the received text information. Also, in the present invention, a method comprises a step of storing text information selectively designated with a designating key in a storage memory. That is, in the present invention, the user selectively decides whether a part of the received text data should be captured by using a first key.

In Matsumoto, since the received text data is automatically captured as a whole regardless of whether the user intends to capture it, the recording system of Matsumoto does not need to have a first key for instructing selective capture of received data, nor does Matsumoto teach or suggest incorporating such feature into the device of Matsumoto.

Moreover, the system of Matsumoto does not need to have a second key for selecting a target unit for title input of the recording medium on which a music signal has already been recorded. In Matsumoto, if the title name in the received text data coincides with the pre-set title, the music associated with the title name is automatically recorded on MD. In short, Matsumoto does not teach or suggest selective capture.

Yuen does not cure the above-referenced deficiencies in Matsumoto. Yuen only teaches a buffer for temporarily storing incoming information (page 3, Paper No. 27). Accordingly, even if Yuen is combined with Matsumoto (which is essentially different from the present invention), the resultant allegedly obvious combination does not teach or suggest that a first system controller stores received text information in a capturing buffer region when a first key instructs to selectively capture the received text information, or a method comprising a step of storing text information selectively designated with a designating key in a storage memory.

Since Matsumoto and Yuen do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration

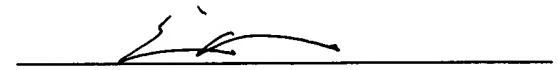
and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Paragraph 2 of the Official Action rejects claims 2, 3, 5 and 6 as obvious based on the combination of Matsumoto, Yuen, JP 03-233670 to Tanosaki and JP 09-146528 to Aida et al.

Please incorporate the arguments above with respect to the deficiencies in Matsumoto and Yuen. Tanosaki and Aida do not cure the deficiencies in Matsumoto and Yuen. The Official Action relies on Tanosaki and Aida to allegedly teach the deletion of duplicate, unwanted characters (page 3, Paper No. 27). However, Matsumoto, Yuen, Tanosaki and Aida either alone or in combination, do not teach or suggest that a first system controller stores received text information in a capturing buffer region when a first key instructs to selectively capture the received text information, or a method comprising a step of storing text information selectively designated with a designating key in a storage memory. Since Matsumoto, Yuen, Tanosaki and Aida do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet 1 of 1

Complete if Known	
Application Number	09/462,075
Filing Date	January 6, 2000
First Named Inventor	Makoto Sato
Group Art Unit	2653
Examiner Name	A. Psitos
Attorney Docket Number	0670-221

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No.[1]	U.S. Patent Document Number	Kind Code[2] (if known)	Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No.[1]	Foreign Patent Document Office[3]	Number[4]	Kind Code[5] (if known)	Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T[6]
		JP	8-317331			11/29/1996		Full
		JP	9-147532			06/06/1997		Full

OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No.[1]	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T[2]
		Written Notification of Reason for Refusal, May 15, 2003, Japanese Patent Office	

Examiner Signature		Date Considered	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

[1] Unique citation designation number. [2] See attached Kinds of U.S. Patent Documents. [3] Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). [4] For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. [5] Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. [6] Applicant is to place a check mark here if English language Translation is attached.

[1] Unique citation designation number. [2] Applicant is to place a check mark here if English language Translation is attached.

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